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23550	7590	09/13/2006	EXAMINER	
HOFFMAN WARNICK & D'ALESSANDRO, LLC			TARAE, CATHERINE MICHELLE	
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ALBANY, NY 12207			3623	

DATE MAILED: 09/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/878,518

Applicant(s)

DELANO ET AL.

Examiner

C. Michelle Tarae

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The following is a Final Office Action in response to the communication received July 5, 2006. Claims 1, 7, 13, 16, 22, 26 and 31 have been amended. Claims 1-35 are now pending in this application.

Response to Amendment

2. Applicant's amendments to claims 11, 7, 13, 16, 22, 26 and 31 are acknowledged.

Response to Arguments

3. Applicant's arguments have been fully considered, but are found unpersuasive.

First, Examiner points out that on page 10 of the Remarks, Applicant states that claims 1-35 were rejected under 35 U.C.S. 112, second paragraph. However, Examiner notes that in the Response to Amendments in the last Office Action mailed April 4, 2006, Examiner indicated that the amendments were sufficient to overcome the 35 U.C.S. 112, second paragraph rejection and therefore, the 35 U.C.S. 112, second paragraph rejection was withdrawn.

In the Remarks, Applicant argues that Puri fails to teach a newly added amendment, which recites: analyzing software application needs of a business entity to determine whether to remove an entity software application.

With regard to the argument, Examiner respectfully disagrees. Examiner notes that the newly added amendment is not being given patentable weight because the

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recitation only occurs in the preambles of the claims. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Examiner further notes that the bodies of the claims that have the newly added amendment in the preamble don't expressly recite anything resembling analyzing software application needs of a business entity *to determine whether to remove an entity software application*. In other words, none of the claims with the newly added amendment in the preamble recite in their bodies making any determination (from analyzing entity responses to questions) on whether to remove any software applications. Accordingly, a new 35 U.S.C. 112, second paragraph rejection is set forth below because the recitation residing in the preamble, but not in the body of the claims, makes unclear the metes and bounds of the claims.

In the Remarks, Applicant also challenges Official Notice assertions made by Examiner.

With regard to the Official Notice challenges, Examiner respectfully submits that the challenges have not been properly made. Examiner notes the following discussion of Official Notice taken from the MPEP:

To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in

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the art. See 37 CFR 1.111(b). See also *Chevenard*, 139 F.2d at 713, 60 USPQ at 241 (“[I]n the absence of any demand by appellant for the examiner to produce authority for his statement, we will not consider this contention.”). A general allegation that the claims define a patentable invention without any reference to the examiner’s assertion of official notice would be inadequate. If applicant adequately traverses the examiner’s assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. See 37 CFR 1.104(c)(2). See also *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 (“[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings” to satisfy the substantial evidence test). If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2). If applicant does not traverse the examiner’s assertion of official notice or applicant’s traverse is not adequate, the examiner should clearly indicate in the next Office action that the common knowledge or well-known in the art statement is taken to be admitted prior art because applicant either failed to traverse the examiner’s assertion of official notice or that the traverse was inadequate. If the traverse was inadequate, the examiner should include an explanation as to why it was inadequate. (MPEP § 2144.03(C))

Applicant has not “specifically point[ed] out the supposed errors in the examiner’s action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art.” Applicant’s broad request for references to support Examiner’s statements of Official Notice amounts to nothing more than an unsupported challenge. Consequently, the statements of Official Notice made in the art rejection have been established as admitted prior art due to Applicant’s failure to adequately traverse the Examiner’s assertions of Official Notice. Therefore, Applicant has not

sufficiently switched back to the Examiner the burden of supplying references in support of her assertions of Official Notice.

In conclusion, Applicant's arguments, have been fully considered, but are found unpersuasive.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 7, 13, 16, 22, 26 and 31 recite in their preambles, analyzing software application needs of a business entity to determine whether to remove an entity software application. However, the bodies of those claims do not recite making any determination whether to remove an entity software application. Therefore, the intended metes and bounds of the claims are unclear because the bodies do not accomplish what the preambles set out to do (i.e., determine whether to remove an entity software application).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Puri (U.S. 6,064,982).

As per claim 1, Puri discloses a computer-implemented method for analyzing software application needs of a business entity to determine whether to remove an entity software application, comprising the steps of:

inventorying a set of entity software applications (col. 2, lines 28-36; col. 3, lines 30-31 and 54-59; col. 4, lines 17-19; Figures 2 and 5; During a needs assessment session of a business entity (i.e., a customer), the system collects the software application (i.e., product) needs of the business entity, and therefore, identifies, or inventories, the business entity's current software application status. Additionally, the smart configurator tool maintains a current list of the software applications (i.e., products) of the entity (i.e., or company selling the products), and thus, inventories the products currently available.);

formulating a set of questions related to the entity software application based on a business strategy corresponding to the business entity, wherein the set of questions are tailored to assess the software application needs of the business entity and to measure how well the entity software application is meeting the software application

needs (col. 1, lines 33-35 and 47-53; col. 3, lines 32-34; col. 5, lines 1-15 and 26-30; Figure 4; The system takes the business entity through a series of interactive questions to learn more about the application needs of the business entity. Item 52 in Figure 4 lists specific software application needs such as information publishing and electronic commerce. The business entity identifies its needs by checking the boxes (item 51 in Figure 4) most relevant to its needs. The needs assessment process measures how well the entity software application is meeting the software application needs of the business entity by recommending products that will actually meet the business entity's software application needs. In other words, a product is recommended only if it is determined in the needs assessment that the business entity needs the product, which means the business entity does not have a current product that meets that particular software application need (i.e., a current software application is not meeting the software application needs of the business entity well).);

receiving entity responses to the set of questions (col. 5, lines 3-8; Figures 4-6; Entity responses are received through an interactive interface.).

Puri does not expressly disclose inventorying a set of entity software applications that are *currently used by the business entity*. Although Puri does disclose a needs assessment through which a business entity identifies technology areas in which they desire software applications (see Figure 4). By identifying technology needs, such as a desire to enhance a web site (statement 4 in Figure 4), a business entity is identifying the hardware and software they are currently using. For example, in order to have a functioning web site, certain hardware and software applications must be in use (such

as web servers). Identifying the software applications that a business entity is currently using, while also receiving their technology needs, provides a recommendation tool such as that of Puri with more comprehensive data to conduct a needs analysis and product recommendation. For example, if a business entity identifies a particular publishing application that it is currently using while also identifying publishing as a technology area that needs improvement, the recommendation tool would not recommend the publishing application that the business entity is currently using (at least not without some modification) as it obviously is not sufficient for the business entity's needs. Thus, at the time of the invention, it would have been obvious to a person of ordinary skill in the art for the system of Puri to inventory a set of entity software applications that are currently used by the business entity as doing so provides the recommendation tool with more comprehensive data with which to conduct a needs assessment, thereby enhancing the analysis and ultimate product recommendation performed by the recommendation tool.

As per claim 2, Puri discloses the method of claim 1, further comprising the step of weighting possible responses to the set of questions based on the business strategy (col. 5, lines 3-15; Figure 4; By allowing an entity to identify needs that are important for its business, the system is in essence weighting the responses. If a particular need is identified, the system guides the entity to answer more questions relating to that need, thereby emphasizing the need.).

As per claim 3, Puri does not expressly disclose the method of claim 2, wherein the step of weighting responses comprises the step of assigning a value for each

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possible response to the set of questions. However, as discussed in claim 2, by allowing an entity to identify needs that are important for its business and then asking additional questions related to those needs, Puri is emphasizing the identified needs and thus, weighting the responses (col. 5, lines 3-15; Figure 4). Assigning a value to a weight is old and well known in the art. Thus, at the time of the invention, it would have been obvious to a person of ordinary skill in the art for the system of Puri to assign values to the needs identified by an entity because doing so allows the system to associate each identified need with a specific worth, providing the system with more accurate and quantifiable data with which to conduct the needs assessment, which is a goal of the Puri system (col. 6, lines 43-46).

As per claim 4, Puri discloses the method of claim 1, further comprising the step of analyzing the received responses to make a set of recommendations (col. 6, lines 5-13 and 43-46; The system provides recommendations to the entity based on the application needs assessment. The application needs assessment includes an interactive tool through which the entity selects from a predetermined question/answer session.).

As per claim 5, Puri discloses the method of claim 1, further comprising the step of generating a report based on the received entity responses (Figure 9).

As per claim 6, Puri discloses the method of claim 1, wherein the entity software applications are grouped by business process (item 42 in Figure 4 shows a business process grouping of the needs to be identified by the entity).

Claims 7-35 recite substantially similar subject matter as claims 1-6 above.
Therefore, claims 7-35 are rejected on the same basis as claims 1-6.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Smith et al. (U.S. 6,477,703) discusses a software patch selection tool.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Michelle Tarae (formerly, C. Michelle Colon) whose telephone number is 571-272-6727. The examiner can normally be reached Monday – Friday from 8:30am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz, can be reached at 571-272-6729.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


C. Michelle Tarae
Patent Examiner
Art Unit 3623

September 7, 2006